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10/796,438	03/08/2004	Carl J. Conforti	003/008	1808

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EXAMINER

PASCUA, JES F

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3782

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,438	Applicant(s) CONFORTI, CARL J.	
	Examiner Jes F. Pascua	Art Unit 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second end of the is configured to have a secondary spring like member spanning across an area opening external to the apparatus body" (claim 8) must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-11 and 26-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 7 and 27, the specification, as originally filed, fails to provide antecedent basis for the claim language “wherein the apparatus is configured to be securely attached to a body vertically suspended” and “wherein the apparatus is configured to be vertically suspended”. Regarding claim 26, the specification fails to provide antecedent basis for the material of the apparatus being “biodegradable and environmentally friendly”. This is a new matter rejection.

It is brought to applicant's attention that no amendment shall introduce new matter into the disclosure of the invention. Applicant is required to indicate where the original specification supports the “vertically suspended” and “biodegradable and environmentally friendly” claim language or cancel the new matter in the reply to this Office Action.

Regarding claim 26, the specification fails to provide an adequate written description of the material of the apparatus being “biodegradable and environmentally friendly”.

Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, first paragraph.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-11 and 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, lines 5-6, the functional recitation “a first end configured to receive articles and self seal at least a portion of the bag” is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function of self sealing.

In claim 7, lines 6-7, the language “self seal at least a portion of the bag spanning a first area in an open position” is confusing. The language appears to be stating the first end self seals in an open position (i.e. open configuration). Clarification of the claim language is requested.

In claim 7, line 8, it is vague as to what is meant by “wherein the bag and first end are of the same”. It is unclear as to what “the same” refers.

Claim 8 is indefinite because it is unclear as to what “the second end of the” refers.

In claim 11, “the body” lacks antecedence in claim from which it depends.

Regarding claim 23, lines 5-7, the functional recitation “a receiving end configured to receive articles passing through a portion of the body storage area, into a chamber to contain and self seal odors inside the body of the apparatus” is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function of self sealing.

Claim 23 is confusing. Lines 2-3 recite “A body configured to receive and store odor producing articles, the body having a first and second end, the second end closed”. Lines 8-10 then recite “an body configured to store both solid and liquid matter inside a chamber contained within the said body, the body having a receiving end at the first end of the body, and having a second sealed end”. It appears claim 23 sets forth the structure of the body twice in the same claim. Clarification of how the two recited bodies are distinct from each other is requested.

In claim 24, structural relationship and association between the apparatus and the “material that is configured to self stick” has not been set forth.

Claim 27 is confusing. Line 2 recites “A body configured to receive and store odor-producing article”, whereas line 7 recites “an odor-inhibiting body like chamber”. Claim 27 appears to be reciting the same element (i.e., a body) twice within the same claim. Clarification of how the two recited bodies are distinct from each other is requested.

In claim 27, line 11, "the sleeve" lacks antecedence within the claim.

Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7-11, 23, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,116,139 to Young et al.

Young et al. discloses a containment apparatus comprising a bag configured to receive and store odor-producing articles (column 1, lines 10-12), the bag having a first and second end (21 and 20, respectively), the second end (20) being closed to retain the odor-producing articles in a chamber (31) defined by the bag and the first end (21) configured to receive articles. Young et al. discloses the bag being made of sheets of plastic such as polyethylene, vinyl, MYLAR or the like (column 3, lines 61-62). The inherent characteristics of the sheets of plastic disclosed by Young et al. meet the recitation "materials configured to inhibit odors from passing through the bag". The Young et al. discloses the bag may be of one piece construction (column 3, line 68 through column 4, lines 1-2), which would result in the first end (21) being the same material as the bag. The bag includes an odor-inhibiting sleeve (i.e., funnel) defined by

a through passage storage area (column 7, lines 57-68). The sleeve of Young et al. also acts to self seal at least a portion of the first end (21) of the bag spanning a first area in an open position. The sleeve has a first end integrally connected to the first end of the bag (column 4, lines 14-24), and has a second end (30) that spans a second area in an open position, the second area being smaller than the first area. Since Young et al. discloses that the bag may be made from sheets of polyethylene, vinyl or MYLAR and that the sleeve may be integrally connected to the first end of the bag, which means the sleeve would also be made from sheets of polyethylene, vinyl or MYLAR.

Furthermore, the Examiner asserts that polyethylene, vinyl and MYLAR each have inherent static self stick properties. Therefore, Young et al. meets, by the principles of inherency, the recitation "the second end of the sleeve providing an opening such that the passage of the sleeve is sealed by a static self stick material with the chamber defined by the body with the sleeve and the bag in closed position". The receptacle Young et al. apparatus is configured to repeatedly attach to itself on an inner surface (via the sleeve), to self-seal the passage thereby inhibiting odors in the chamber defined by the bag from passing through the apparatus. The Young et al. apparatus is configured to detach from itself (via the sleeve) to open with an applied force and allow an article (i.e. vomit) to pass into the chamber of the bag. The Young et al. apparatus is configured to be securely attached to a body vertically suspended (Fig. 13) to receive and store various odor producing articles.

Regarding claim 8, Young et al. discloses stiffeners (54, 56) at the second end of the sleeve forcing the sleeve closed, which meets the recitation "the second end of the

is configured to have a secondary spring like member spanning across an area opening external to the apparatus body."

Regarding claim 11, the attaching mechanism in Young et al. that allows the body to be vertically suspended is capable of permitting the body to be attached to a trash receptacle.

Regarding claim 26, the polyethylene, vinyl and MYLAR disclosed by Young et al. are considered to be "biodegradable and environmentally friendly" to the same degree as claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,116,139 to Young et al.

Regarding claims 25 and 28, Young et al. discloses the claimed invention, especially the material of the bag being polyethylene, vinyl or MYLAR. However, Young et al. does not disclose the bag being made from PVDC, Saran Wrap or linear low density polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use PVDC, Saran Wrap or linear low density polyethylene for the bag material of Young et al., since it has been held to be within the

Art Unit: 3782

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 29, Young et al. discloses the claimed invention except for the bag material comprising paper and a thin layer of water soluble plastic or paraffin base and self stick material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use paper and a thin layer of water soluble plastic or paraffin base and self stick material for the bag material of Young et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 30, Young et al. discloses the claimed invention, especially the material of the bag being polyethylene, vinyl or MYLAR. However, Young et al. does not disclose the bag being made from a thin flexible polyethylene combined with a polyester layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to a thin flexible polyethylene combined with a polyester layer for the bag material of Young et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Response to Arguments

10. Applicant's arguments with respect to claims 7-11 and 23-30 have been considered but are moot in view of the new grounds of rejection.

Conclusion

11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$510.00.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3782

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jes F. Pascua/
Primary Examiner, Art Unit 3782